

**REMARKS**

**I. Introduction**

Pending claims 1-45 are have been examined. Claims 1-45 stand rejected solely under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-9 of Baer et. al, U.S. Patent No. 6,449,627 (hereinafter "'627").

Applicants traverse the double patenting rejection as follows.

**II. Double-Patenting Rejection**

The Examiner rejects claims 1-45 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over '627. In particular, the Examiner states that although the conflicting claims are not identical, "they are not patentably distinct from each other because the claimed subject matter and limitations of the instant application has been fully described in the patent" (Office Action, page 2). Applicants respectfully traverse this grounds of rejection because: (1) the Examiner has failed, procedurally, to establish *prima facie* obviousness; (2) the Examiner applies an incorrect standard in alleging that "the claimed subject matter and limitations of the instant application has been fully described in ['627]" and (3) the present claims are not obvious modifications to the claims set forth in the patent relied upon by the Examiner.

First, the Examiner has failed, procedurally, to establish *prima facie* obviousness. To meet his initial burden, the Examiner must explain with reasonable specificity at least one

rejection, otherwise he procedurally fails to establish *prima facie* obviousness.<sup>1</sup> That is, even an obvious-type double patenting rejection must employ the same factual inquiries as in a rejection made under 35 U.S.C. § 103(a), and should make clear both the differences between the inventions defined by the conflicting claims, and **the reasons why** a person of ordinary skill in the art would conclude that the invention defined in a claim in issue is an obvious variation of the invention defined in a claim in the patent.<sup>2</sup>

Here, the Examiner fails to explain with reasonable specificity, at least one rejection. Instead, the Examiner merely states that “the claimed subject matter and limitations of the instant application have been fully described in the patent”; the Examiner does not give any reasons why a person of ordinary skill in the art would reach his same conclusion. But such mere allegations by the Examiner, that the claimed subject matter is obvious, do not create a presumption of unpatentability.<sup>3</sup> Instead, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness.<sup>4</sup> This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art.<sup>5</sup>

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<sup>1</sup> See *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989); MPEP § 2142.

<sup>2</sup> See MPEP § 804(B)(1).

<sup>3</sup> See *In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963).

<sup>4</sup> See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

<sup>5</sup> See *In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984).

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Here, the Examiner has provided no objective teaching in support of his allegations .  
Further, the Examiner gives no reasoning at all, let alone "cogent reasoning", that these elements are obvious modifications of one another.

Second, the Examiner applies an incorrect standard in alleging that "the claimed subject matter and limitations of the instant application has been fully described in ['627]". When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in a claim of a patent, the disclosure of the patent may **not** be used as prior art.<sup>6</sup> Instead, to the extent possible, the Examiner should limit his use of '627 to claims 1-9 therein.

Third, claims 1-45 of the present application are not obvious modifications to claims 1-9 set forth in the patent relied upon by the Examiner, *i.e.*, '627. That is, claims 1-15, 16-30 and 31-45 of the application are directed to a method, program storage device and system for "configurably loading a data object comprising a plurality of hierarchically related entities and information specifying the hierarchical relationship of the entities", respectively. Disparately, claims 1-3, 4-6 and 7-9 of '627 are directed to a method, program storage device and system for "managing volume container limits in a compilation comprising a plurality of content entities and at least one volume containing the content entities", respectively. It is respectfully submitted that these limitations are not obvious in view of each other, and accordingly, it is improper to reject the claims under the doctrine of double patenting.

Thus, because (1) the Examiner has failed, procedurally, to establish *prima facie* obviousness; (2) apply the appropriate standard in rejecting Applicants' claims under the judicially created doctrine of obviousness-type double patenting and (3) the present claims are not obvious modifications to the claims set forth in the patent relied upon by the Examiner, claims 1-45 of the application are patentably distinct from the claims of '627. Accordingly, the application is believed to be in condition for immediate allowance.

### III. Submission of Appendix on CD-R

Submitted herewith for filing in the present application is a Compact Disc-Recordable (CD-R) having recorded thereon an ASCII text computer program listing prepared in compliance with C.F.R. §1.96, and a duplicate copy of the CD-R. The computer program listing was created and stored on the CD-R in IBM-PC format using a Microsoft Windows operating system. Each CD-R is physically labeled with the title of the invention, the docket/application numbers of the application, the creation date of the CD-R and an indication of the inventorship. Two copies of the CD-R are provided (numbered CD #1 of 1 / Copy 1 and CD #1 of 1 / Copy 2, respectively), with each copy containing the file detailed below.

File Contents of CD #1 of 1:

File Name	Files Size	Creation Date
AppendixA.txt	107 KB	5/16/2002

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<sup>6</sup> See MPEP § 804(B)(1).

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#### **IV. Formal Matters**

##### Information Disclosure Statement

Furthermore, Applicants thank the Examiner for acknowledging consideration of the references submitted with the IDS filed on April 25, 2000.

##### Specification

Applicants make several corrective amendments to the specification.


#### **V. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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